

Serial No. 10/522,089
Art Unit 2621

PD020071
Customer No. 24498

REMARKS

Applicants have reviewed this application in light of the Office Action dated April 24, 2009 and in view of the recent telephone call between the examiner and the undersigned attorney. Applicants have cancelled claim 8 and incorporated its subject matter into claim 1. Further, applicants have amended claim 1 to recite the added material in the form of gerund verb phrases in accordance with US Patent Practice. Applicants have added new claim 12 to include the subject matter referring to extending auxiliary data files deleted from claim 1. The amendments to the claims do not add any new matter. Following this amendment, claims 1, 4-7 and 9-12 remain in this application. Applicants request reconsideration of the rejection in light of the arguments and the amendments.

The Examiner has indicated that claim 8 includes allowable subject matter. Applicants have added the subject matter of claim 8 to claim 1. Claim 4, from which claim 8 depends, has not been incorporated, because the features of claim 8 do not require any of the features of claim 4. All of claims 4-7 and 9-12 now include the subject matter of cancelled claim 8 by virtue of their respective dependencies from claim 1.

Claim 1, as amended now recites that a video encoder performs the steps of the method. As now amended, claim 1, and the claims that depend therefrom, satisfy the "machine" prong of the machine or transformation test, and thus constitute patentable subject matter under 35 U.S.C. §101.

Claims 1, 4-5, and 7 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Coding of Parameter Sets by Hannuksela et al. (hereinafter "Hannuksela").

Since claim 1 now includes subject matter which the Examiner deemed allowable with regard to previously pending claim 8, applicants assert that Hannuksela fails to disclose or suggest all of the elements of claim 1. Thus, claim 1 now recites patentable subject matter. Claims 4-5 and 7 depend from claim 1 and include all of its elements. Claims 4-5 and 7 also recite patentable subject matter. Applicants request withdrawal of the 35 U.S.C. § 102(a) rejection of claims 1, 4-5, and 7.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hannuksela in view of U.S. Patent No. 6,493,028 to Anderson et al. (hereinafter "Anderson").

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Claim 6 depends from claim 1 and includes all of its elements. Claim 6 thus recites subject matter which the Examiner has deemed allowable. Therefore, Hannuksela and/or Anderson, taken alone or in combination, fail to disclose or suggest all of the elements of claim 6. Applicants request withdrawal of the 35 U.S.C. § 103(a) rejection of claim 6.

Claims 9-11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hannuksela in view of U.S. Patent No. 5,926,208 to Noonon et al. (hereinafter "Noonon"). Claims 9-11 depend from claim 1 and incorporate by reference all of the elements of their respective parent claims. Claims 9-11 now include subject matter which the Examiner has deemed allowable. Therefore Hannuksela and/or Noonon, taken alone or in combination, fail to disclose or suggest all of the elements of claims 9-11. Applicants request withdrawal of the 35 U.S.C. § 103(a) rejection of these claims.

Conclusion

In view of the foregoing, applicants solicit entry of this amendment and allowance of the claims. If the Examiner cannot take such action, the Examiner should contact the applicant's attorney at (609) 734-6820 to arrange a mutually convenient date and time for a telephonic interview.

No fees are believed due with regard to this Amendment. Please charge any fee or credit any overpayment to Deposit Account No. 07-0832.

Respectfully submitted,
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